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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	F. Burkamp et al.		
Serial No.:	10/579355	Case No.:	T1642P
Filed:	May 12, 2006		
For:	Indazol-3-ones and Analogues and Derivatives Thereof which Modulate the Function of the Vanilloid-1-Receptor (VR1)		

Art Unit
4131

Auth. Off.:
K. Branch

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This paper is filed in response to the restriction requirement of January 22, 2008 for which a response is due on February 22, 2008. Claims 1-10 are subject to the following restriction under 35 U.S.C. 121:

Group I, Claims 1-5 drawn to compounds and compositions of the formulas (I) and (IA).
Group II, Claim 8 drawn to a process for preparation of a compound of the formula (I).
Group III, claims 9 and 10 drawn to methods for the treatment or prevention of physiological disorders and a disease or condition which comprises administering a compound or a composition of formula (I).

Applicants respectfully traverse the restriction requirement. The Examiner asserts that the restriction is proper because the inventions listed in Groups I to III do not relate to a single general inventive concept under PCT Rule 13.1 in that they lack the same or corresponding technical features. Applicants respectfully submit that the Examiner fails to justify the restriction requirement as the present invention of Groups I-III are related. Even though only one invention may be claimed in a single application, a reasonable number of species of the invention can be claimed if there is an allowable generic claim in the application, which is the case of the present application.

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Accordingly, there is no additional burden on the part of the Examiner to conduct the prior art search for examination of the present application in total. Additionally, method claims 9 and 10 relate to treating pain and/or inflammation that is associated with VR1 activity and depend upon claim 1. Thus, the Examiner is herein requested to apply procedures for the rejoinder of withdrawn method claims 9 and 10 consistent with MPEP 821.04 (e.g. the Official Gazette Notice (1184 O.G. 86) of March 26, 1996, and the "Training Materials for Treatment of Product and Process Claims in Light of In re Brouwer and In re Ochiai and 35 U.S.C. 103 (b)"). Applicants note that the method claims already include all the limitations of the main product claim.

As required by the Examiner, Applicants elect the invention of Group 1 and select the compound of Example 1 to be examined. Applicants further assert that claims 1 through 7, 9 and 10 are identified as encompassing the elected invention.

Claims 6 and 7 are rejected for being written in an improper format pursuant to 35 USC 101. Claims 6 and 7, which are essentially duplicates of claims 9 and 10 and will be canceled in Applicant's next correspondence.

Applicants would like to bring to the attention of the Examiner that the filing date of May 11, 2006 appears to be incorrect. Our records reflect that the application was filed on May 12, 2006. All dates in our file, including the USPS Express Mail receipt, indicate a date of May 12th. Kindly check your records and advise if you agree with our findings.

In view of the above, the Examiner is respectfully requested to withdraw the restriction requirement.

Authorization is hereby given to charge any fees which may be due as a result of this petition to Deposit Account No. 13-2755.

Respectfully submitted,

By: 

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